

REMARKS

In regard to the Examiner's claim rejections under 35 U.S.C. Article 103, the Examiner has rejected Claims 1 to 40 for obviousness. In more detail, the Examiner at Paragraph 4, contends that Claims 1 to 7, 10-20, 23-26, 27-34 and 37-40 are obvious when *Phanouriou et al* is combined with *Eagar et al*. Moreover at Paragraph 26, the Examiner contends that Claims 8, 21 and 35 are obvious when *Phanouriou et al*. when combined with *Eagar et al*. and *Apte et al*. Finally, at Paragraph 29, the Examiner contends that Claims 9, 22 and 36 are obvious in view of *Phanouriou et al*. when combined with *Eagar et al*. and *Harold*.

Applicant has amended each of the independent Claims 1, 14 and 28. Claim 27 has been cancelled as have Claims 2, 8, 9, 15, 21, 22, 29, 35 and 36.

Applicant has included the features of Claims 2, 8 and 9 into Claim 1 (and also correspondingly) the features of Claims 15, 21 and 22 have been included into Claim 14; and the features of deleted Claims 29, 35 and 36 have been included into Claim 28).

The claimed invention, in at least the independent claims, now defines a system and/or method which allows a user to automatically produce a graphical user interface (GUI) suitable for use in a networked computing environment, where the GUI is produced from screen definitions in legacy source code. Moreover, the independent claims now define the further feature of the automatically produced interface being capable of running within a scripting language.

This provides the attendant advantage of the automatically produced interface being capable of customization by the end user (for support for this feature, see generally Page 37 at Line 19 through Page 28 and 39 up to Line 18, Page 39). For example, this allows the interface to be modified by the provision of an HTML format which executes the Java™ based GUI within a script in the webpage.

As the independent claims now incorporate features not disclosed in either *Phanouriou et al.* or *Eagar et al.*, even when both documents are combined, it is respectfully submitted that Examiner's objections at Paragraphs 4-25 are traversed.

As to Examiner's objections at Paragraphs 26-39, it is respectfully submitted that it would be unlikely that a skilled person would combine *Phanouriou*, *Eagar*, *Apte* and *Harold*, as there is no motivation or teaching in *Phanouriou* to combine *Phanouriou* with *Eagar*, *Apte* or *Harold*. *Phanouriou* is directed to a method for providing a GUI capable of interfacing with a legacy application.

Phanouriou, by its very nature, discusses the possibility of running a Java™ applet within a web browser. (See for example, Page 1 of 11 at Paragraph 2, section entitled "Introduction".) *Phanouriou* further teaches that if the user desires a change in the interface, the Java™ applet itself must be modified through the so-called "UI Mapping Rules". (See generally last paragraph of Page 7 of 11 and Page 8 of 11.)

There is absolutely no suggestion or teaching in *Phanouriou* that the "look and feel" of the Java™ application may be changed by running the Java™ within a script on a webpage. Therefore, a skilled person, on reading *Phanouriou*, and presented with the problem of wishing to change the look and feel

of the graphical user interface, would automatically assume that this would be done through the changing of UI Mapping Rules. There is absolutely no teaching of alternate methods to change the look and feel of the GUI.

As the skilled person is presented with one possible solution for changing the look and feel of the graphical user interface, there is no motivation for the skilled person to seek other solutions. Therefore, there would be no reason for the skilled person to search for, read and understand the relevance of Apte et al. In other words, as one implicit solution to the problem can be found, then it is respectfully submitted that a skilled person would find no motivation to combine Phanouriou with Apte. The Examiner's suggestion that a person of ordinary skill in the art would combine the teachings of Phanouriou, Eagar and Apte because "it can expose useful properties of Java™ applets" does not establish *prima facie* obviousness.

The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness (see *In re Mills*, 916 F.2d, p.680, 16 USPQ2d, pp.1430 (Fed.Cir 1990)). Moreover, it appears the Examiner at Paragraph 27 is utilising an "obvious to try" argument. The Examiner suggests that a person of ordinary skill would have combined Phanouriou, Eagar and Apte simply for the reason that Apte described one useful property of the Java™ programming language.

However, the Java™ programming language contains many useful properties, and without an explicit motivation to explore and discover the property of the Java™ programming

language utilised in the claimed invention, it is not seen how the person of ordinary skill would arrive at Apte.

Regarding the question of combining references and the requirement for evidence of motivation to combine the attached Appendix I will further amplify the case law in this regard.

As a result, it is respectfully requested that Examiner consider Applicant's claims as a whole in their entirety and subsequently provide a timely Notice of Allowance.

Respectfully submitted,

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May 18, 2006

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APPENDIX I

Basically, in the present situation, the Examiner is basing his contentions by combining various technologies from various cited references and saying they could be combined to provide the same configuration that is stated in Applicants' claims. First, it must be said that these cited technologies could not provide the specific configuration of modules as provided by Applicants. And further, the present patent law requires that there should be indicated some "motivation" for an Examiner to conclude that the combination of such references is an operable possibility.

The Patent Office has set forth in MPEP 706.02 a three-step requirement for establishing a *prima facie* case of "obviousness". The first step requires that the Examiner must set forth the differences in the claim over the applied references.

The second step requires that the Examiner must set forth the proposed modification of the reference which would be necessary to arrive at the claimed subject matter. And, as a third step, this requires that the Examiner explain why the proposed modification (or combination) would be "obvious".

In the Court decision of In re Bozek, 133 USPQ 545 (CCPA 1969). Here, the Court held:

"One can properly rely . . . on a conclusion of obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

But then specifically, in this case, the Courts required the Examiner to identify where the prior art provides a "motivating suggestion" for the modification, as for example, in the decision of In re Jones, 21 USPQ2d 1941 (Fed.Cir.1992), where the Court had held:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness there must be some suggestion for doing so. . . . In re Fine, 5USPQ2d 1596, 1598-99 (Fed.Cir.1988).

To add further to the legal thinking in this situation, a recent decision of the Board of Patent Appeals and Interferences (In re Kahn, Fed.Cir. No.04-1616, 3/22/06), this indicated that ---

an obviousness rejection must articulate the motivation, suggestion or teaching that would have led the skilled artisan at the time of invention to combine prior art elements to make the claimed invention. (underlines added).

This case of In re Kahn indicated that ---- absent such an explanation (reason for motivation) we infer, said the Court, that the Board used hindsight to conclude that the invention was obvious.

In this Kahn case, the Court said -- to establish a *prima facie* case of obviousness based on a combination of prior art elements, the Board must articulate the basis on which it concludes it would have been obvious to make the claimed invention ---- when the Board does not explain the motivation, the suggestion, or the teaching, ---- that would have lead the skilled artisan at the time of the invention to

the claimed invention as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.

Thus, it is incumbent upon the Examiner to present some evidence or reason why the Eager reference could or should be combined with the Phanouriou reference, and what exactly would be the reason or motivation for making such a combinative step?

As was previously mentioned in earlier amendments, the Courts have indicated that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggests the desirability for the modification. As for example, in the decision of In re Fritch, 23 USPQ2d 1780 (Fed.Cir.1992), where the Court held:

Mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention obvious unless desirability of such modification is suggested by prior art (at page 1780).

Further, it has been later set forth that the "motivating suggestion" must be explicit as was decided in the case of Winner International Royalty Corp. v. Wang, Case No. 96-2107, 48 USPQ2d 1139 (District Court D.C. 1998), where the Court held:

Invention cannot be found obvious unless there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention (underlines added).

In light of the above legal requirements, Applicants would ask --- where is the evidence or suggestion to motivate a skilled engineer to take the technology of Eager and apply it to the technology of Phanouriou?

Absent such evidence of motivation to do so, it is improper to contend that the Eager reference could so easily be applied to the Phanouriou reference to establish the equivalent of Applicants' configuration.

In view of the inappropriateness of combining the references in the manner that Examiner has tried to do, it is respectfully requested that the present claims be viewed as a whole in their entirety, and on the basis that neither of the references to Phanouriou, Eager, Apte or Harold, when put in combination, could provide the equivalency of Applicants' stated claims.